UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/091,608	05/17/1999	CHRISTOPHER ROBERT BEBBINGTON	48418	5129

21874 7590 10/03/2003

EDWARDS & ANGELL, LLP
P.O. BOX 9169
BOSTON, MA 02209

EXAMINER	
WOITACH, JOSEPH T	
ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/091,608	BEBBINGTON ET AL.	
	Examiner	Art Unit	
	Joseph T. Woitach	1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *02 September 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, ~~the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.~~

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *11,21-24,28-31,33-42,46,47 and 53*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Deborah Reynolds

DEBORAH J. REYNOLDS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 5. does NOT place the application in condition for allowance because: Applicants do not contest that each of the limitations encompassed by the instant claims are made obvious by cited references. Summarizing the basis of the rejection Applicants argue that Roberts, Seed and Capon do not specifically provide motivation to practice or combine the teachings of Adair, nor does Adair provide motivation to use the teachings of Roberts, Seed and Capon. In summary Applicants acknowledge the motivation set forth by Examiner for using a CDR grafted antibody but argue that none of the references specifically teach to search out and practice the teachings of the others. Applicnats arguments have been fully considered but not found persuasive. It appears that Applicants are arguing that the cited references do not expressly suggest the claimed invention. However, it is well established in case law that a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. In re Burkel, 201 USPQ 67 (CCPA 1979). Furthermore, in the determination of obviousness, the state of the art as well as the level of skill of those in the art are important factors to be considered. The teaching of the cited references must be viewed in light of these factors. Again Applicants do not contest that each of the limitations encompassed by the claims are made obvious by cited references. Additionally, Applicants do not contest the rational or validity of the motivation provided by Examiner in the basis of the rejection only that the references do specifically state to use the teachings of the others. In this case Adair clearly teaches immunogenicity of foreign anibodies delivered to a subject and clearly provide the motivation to use CDR grafted antibodies when delivering an antibody to a subject. The teachings of Robert, Seed an Capon also deal with delivery of recombinant antibodies to subjects. The teaching of Adair clearly suggests the importance of using CDR grafted antibodies when deliverying antibodies to a subject as indicated by the Examiner in the basis of the rejection. The teachings of Seed, Roberts and Capon deal primarily with delivery mechanisms for delivery of recombinant antibodies and do not overcome the problem of immunogenicity recognized in the art as taught by Adair. The courts have held that the test for combining references is not what the individual references themselves suggest, but rather what the combination of disclosures taken as a whole would have suggested to one of ordinary skill in the art. In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). For the purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references. In re Nilssen, 7 USPQ2d 1500 (Fed. Cir. 1988). In this case, the teachings of the references as a whole clearly provide the details and motivation to mak obvious the instantly claimed invention .